

REMARKS

I. Introduction

Claims 1 and 5-13 remain pending in the present application. No claims have been amended, or canceled. The Examiner has withdrawn claim 13 from further consideration. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 1, 5 and 7-12

Claims 1, 5 and 7-12 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by United States Patent No. 6,302,190 (“Clamp”). For at least the following reasons, Applicants respectfully submit that pending claims 1, 5 and 7-12 are patentable over Clamp.

To anticipate a claim under §102(b), each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

To the extent the Examiner continues to contend that Clamp teaches “the cooling device [which] includes at least one one-piece cooling tube (Fig. 2, the path including and between elements 46 and 48 through which coolant flows) integrally formed in the bottom section (see Fig. 2) and extending substantially across the length of the bottom section (see Fig. 2),” the Examiner is asserting an overly broad interpretation of the claimed term “one-piece cooling tube.” In this regard, Applicants previously noted in the Amendment of January 31, 2008 that the amendment of the claimed feature “one-piece cooling duct” to “one-piece cooling tube” was made in order to highlight the fact that the cooling device of the present invention is a fully enclosed conduit formed of a single piece, as clearly shown in Figs. 1-3 and fully described in the original Specification,

e.g., p. 2, l. 28 – p. 3, l. 6, and p. 3, l. 18-21. The Examiner previously characterized Clamp element (40) as a “one-piece cooling **duct** integrally formed in the bottom section,” and cited the American Heritage Dictionary, 4th edition for the definition of “duct.” In the same American Heritage Dictionary, the term “**tube**” is defined as: “1. A hollow **cylinder**, esp. one that conveys a fluid or functions as a passage. 2. A flexible **cylindrical** container sealed at one end and having a screw cap at the other, for pigments, toothpaste, or other substances. 3a. An electron tube. b. A vacuum tube. [slang definitions omitted].” All of these definitions indicate “tube” to mean an enclosed hollow structure. In contrast, the **three sided** structure shown in Fig. 2 of Clamp (the path between elements 46 and 48) is **not** an enclosed hollow structure by itself; instead, the three sided structure (40) in Fig. 2 of Clamp is **not enclosed until a second, separate structure, plate (34) in Fig. 2 of Clamp, is attached**. Thus, Fig. 2 of Clamp clearly does not disclose any “**one-piece** cooling **tube** integrally formed in the bottom section and **extending substantially across the length of the bottom section**,” and there is no logical basis to contend that Clamp shows the **identical invention in as complete detail as is contained in the claim**.

For at least the foregoing reasons, Applicants submit that claim 1 and its dependent claims 5 and 7-12 are not anticipated by Clamp.

III. Rejection of Claim 6

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,302,190 (“Clamp”) in view of U.S. Patent 4,652,970 (“Watari”). For the following reasons, Applicants respectfully submit that claim 6 is patentable over the combination of Clamp and Watari.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to [modify] the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex,

Inc., 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id., at 1396. To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

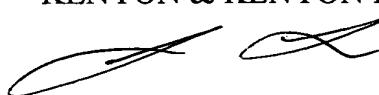
Claim 6 depends on claim 1. As noted above, Clamp clearly does not anticipate parent claim 1. In addition, Watari clearly does not remedy the deficiencies of Clamp as applied against parent claim 1. Accordingly, even if one assumed for the sake of argument that some motivation existed for combining the teachings of Clamp and Watari, with which assumption Applicants do not agree, the overall teachings of Clamp and Watari would not render obvious claim 1 and its dependent claim 6. Therefore, the obviousness rejection of claim 6 should be withdrawn.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that all pending claims 1 and 5-12 of the present application are in allowable condition. Prompt reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

KENYON & KENYON LLP

 (R No.
36,197)

Dated: September 24, 2008

By: SONG LEE for Gerard messina
Gerard A. Messina
Reg. No. 35,952
One Broadway
New York, New York 10004
Telephone: (212) 425-7200
Facsimile: (212) 425-5288
CUSTOMER NO. 26646